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10/674,284	09/29/2003	Joshua S. Lieberman	460.1882USQ3	3114

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EXAMINER
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SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/674,284

Applicant(s)

LIEBERMAN ET AL.

Examiner

James N. Smalley

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 9-12,33-36,58,59 and 69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,13-32,37-57,60-68 and 70-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/24/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. In a telephone call with Andrew Gust, Reg. 47,620, on 21 July 2005, Applicant clarifies the Response to Restriction Requirement/Election improperly states the election of Group (I). Applicant's response clearly states the intent to elect the embodiment of figures 4-9, Group (II). Examiner notes all claims drawn to the embodiments of groups (I), and (III), are withdrawn.
2. Applicant's election with traverse of Group (II) in the reply filed on 17 June 2005 is acknowledged. The traversal is on the ground(s) that a) the claims are generic to all three embodiments; and b) it would be more economical and expedient to search and examine all three embodiments. This is not found persuasive because withdrawn claims 9-12 and 33-36 are not generic to the elected embodiment, as they require multiple first valve faces. To the best degree the Examiner understands the claimed invention, the claims are unique to the embodiment of figures 10-13. Applicant's own Specification, in the Brief Description of the Drawings, declares this an alternative embodiment to the elected embodiment. Withdrawn claims 58-59 and 69 are furthermore not generic to the elected embodiment because they require a concave and downwardly and inwardly curved valve face, which appears to be unique to the embodiment of figure 3.

Regarding the Applicant's second grounds for traversal, Examiner notes the economy and expediency of examining an invention are not a legal basis for traversal. Examiner again notes Applicant's Brief Description of the Drawings, which clearly acknowledges multiple inventions.

The requirement is still deemed proper and is therefore made FINAL. Applicant's own Specification, in the Brief Description of the Drawings, declares this an alternative embodiment to that of the elected invention.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8, 13-29, 32, 37-41, 44-55, 57, 60-68 and 70-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins US 5,706,973 in view of Boucher US 2004/0195253.

Robbins '973, in the embodiment of figure 9, teaches a drinking cup and lid, comprising a one-piece elastomeric valve.

Robbins '973 does not teach the valve face disposed on a sidewall portion of the valve stack.

Boucher '253 teaches a one-piece elastomeric valve element for use in a beverage cup lid, comprising a valve (60) on a sloped sidewall (46). The reference teaches in paragraphs [0034] and [0035] the sloped face allows for a longer slit, which in turn reduces "surge" and allows the valve to open more gently, and, reduces leakage when inverted to do reduced head pressure above the valve.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stack of Robbins '973, providing the valve stack of Boucher '253, motivated by the benefit reducing surge and leakage through the valve.

Regarding claims 5 and 29, Examiner notes the valve face of Boucher '253 is ovular and thus held to be "arcuate," about its periphery.

5. Claims 6-7 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins US 5,706,973 in view of Boucher US 2004/0195253, and further in view of Larson et al. US 5,474,028.

Robbins '973, as modified above, does not teach the valve comprising more than one slit.

Larson '028, in figures 1B and 1C, teaches the equivalence of a straight slit and a criss-cross slit.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve slit of Robbins '973, replacing the straight slit with a criss-cross slit, as taught to be an equivalent valve mechanism by Larson '028.

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6. Claims 42-43 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robbins US 5,706,973 in view of Boucher US 2004/0195253, and further in view of Belanger US 5,890,619.

Robbins '973, as modified above, does not teach the second valve being a duckbill valve.

Belanger '619, in the embodiment of figure 6, teaches a venting valve of the type known as a "duckbill" for venting air into a beverage container, while preventing leakage. Examiner notes valves are well-known devices, and many structures function equally in allowing only one-way passage of fluid. The "duckbill" vent valve is a functional equivalent of the vent valve of Robbins '973, as they both allow air to pass across the valve into the container, while preventing liquid to leak.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stack of Robbins '973, providing a duckbill vent valve, such as that taught by Belanger '619, because such is a mechanically equivalent valve structure equally capable of venting air into the container while preventing liquid leakage.

#### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 1-5, 8, 13-29, 32, 37-41, 44-55, 57, 60-68 and 70-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-10, 13-14 and 17-18 of U.S. Patent No. 6,050,445 ("the 445 patent") in view of Boucher US 2004/0195253.

The '445 patent does not teach the valve face disposed on a sidewall portion of the valve stack.

Boucher '253 teaches a one-piece elastomeric valve element for use in a beverage cup lid, comprising a valve (60) on a sloped sidewall (46). The reference teaches in paragraphs [0034] and [0035] the sloped face allows for a longer slit, which in turn reduces "surge" and allows the valve to open more gently, and, reduces leakage when inverted to do reduced head pressure above the valve.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stack of the '445 patent, providing the valve stack of Boucher '253, motivated by the benefit reducing surge and leakage through the valve.

9. Claims 6-7 and 30-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-10, 13-14 and 17-18 of U.S. Patent No. 6,050,445 ("the 445 patent") in view of Boucher US 2004/0195253, and further in view of Larson et al. US 5,474,028.

The '445 patent does not teach the valve comprising more than one slit.

Larson '028, in figures 1B and 1C, teaches the equivalence of a straight slit and a criss-cross slit.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve slit of the '445 patent, replacing the straight slit with a criss-cross slit, as taught to be an equivalent valve mechanism by Larson '028.

10. Claims 42-43 and 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-10, 13-14 and 17-18 of U.S. Patent No. 6,050,445 ("the 445 patent") in view of Boucher US 2004/0195253, and further in view of Belanger US 5,890,619.

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The '445 patent does not teach the second valve being a duckbill valve.

Belanger '619, in the embodiment of figure 6, teaches a venting valve of the type known as a "duckbill" for venting air into a beverage container, while preventing leakage. Examiner notes valves are well-known devices, and many structures function equally in allowing only one-way passage of fluid. The "duckbill" vent valve is a functional equivalent of the vent valve of the '445 patent, as they both allow air to pass across the valve into the container, while preventing liquid to leak.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stack of the '445 patent, providing a duckbill vent valve, such as that taught by Belanger '619, because such is a mechanically equivalent valve structure equally capable of venting air into the container while preventing liquid leakage.

11. Claims 1-5, 8, 13-29, 32, 37-41, 44-55, 57, 60-68 and 70-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-9, 11-17 and 19-23 of U.S. Patent No. 6,422,415 ("the '415 patent") in view of Boucher US 2004/0195253.

The '415 patent does not teach the valve face disposed on a sidewall portion of the valve stack.

Boucher '253 teaches a one-piece elastomeric valve element for use in a beverage cup lid, comprising a valve (60) on a sloped sidewall (46). The reference teaches in paragraphs [0034] and [0035] the sloped face allows for a longer slit, which in turn reduces "surge" and allows the valve to open more gently, and, reduces leakage when inverted to do reduced head pressure above the valve.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stack of the '415 patent, providing the valve stack of Boucher '253, motivated by the benefit reducing surge and leakage through the valve.

12. Claims 6-7 and 30-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-9, 11-17 and 19-23 of U.S. Patent No. 6,422,415 ("the '415 patent") in view of Boucher US 2004/0195253, and further in view of Larson et al. US 5,474,028.

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The '415 patent does not teach the valve comprising more than one slit.

Larson '028, in figures 1B and 1C, teaches the equivalence of a straight slit and a criss-cross slit.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve slit of the '415 patent, replacing the straight slit with a criss-cross slit, as taught to be an equivalent valve mechanism by Larson '028.

13. Claims 42-43 and 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-9, 11-17 and 19-23 of U.S. Patent No.

6,422,415 ("the '415 patent") in view of Boucher US 2004/0195253, and further in view of Belanger US 5,890,619.

The '415 patent does not teach the second valve being a duckbill valve.

Belanger '619, in the embodiment of figure 6, teaches a venting valve of the type known as a "duckbill" for venting air into a beverage container, while preventing leakage. Examiner notes valves are well-known devices, and many structures function equally in allowing only one-way passage of fluid. The "duckbill" vent valve is a functional equivalent of the vent valve of the '415 patent, as they both allow air to pass across the valve into the container, while preventing liquid to leak.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stack of the '415 patent, providing a duckbill vent valve, such as that taught by Belanger '619, because such is a mechanically equivalent valve structure equally capable of venting air into the container while preventing liquid leakage.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:  
See attached PTO-892, citing related references.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns



NATHAN J. NEWHOUSE  
PRIMARY EXAMINER